

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARVIN LASKY and LESTER F. WHICKER

Appeal No. 2003-0209
Application No. 04/394,390

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 11. Claims 1 through 10, all of the other claims remaining in this application, stand allowed. Claim 12 has been canceled.

Appellants' invention relates to a submarine towed instrument positioning device and more particularly to a device to tow sound receiving apparatus by a submarine while cruising in

water for measuring near-sound noise generation of the submarine which may then be analyzed in an attempt to provide a more quiet ship. Of importance to appellants is to provide a towed device (12, 30, or 60) that is positionable in the water with respect to the towing vehicle and which allows the towed array to be positioned in a spaced manner from the submarine and substantially parallel to the line of submarine travel. A portion of the mechanism for changing positioning of the towed device is contained within the housing of the device and includes means (Figs. 3-5 or Figs. 6-8) for varying the relative position between the center of buoyancy and the center of gravity of the housing to dispose the wing (33 or 65) in a given position.

Claim 11 reads as follows:

11. A towed vehicle for positioning a hydrophone array about a submarine, comprising:

(a) towing means connecting said submarine and vehicle;

(b) means on said vehicle for generating hydrodynamic forces as the vehicle is pulled through water; and

(c) means for selectively controlling the attitude of said vehicle whereby the hydrophone array may be positioned substantially parallel to the axis of the submarine at any radial position of the vehicle about the submarine.

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The sole prior art reference relied upon by the examiner in rejecting claim 11 is:

Anderson	3,125,980	Mar. 24, 1964
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Claim 11 stands rejected under either 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as being unpatentable over Anderson.

According to the examiner, Anderson

discloses a towed vehicle comprising towing means, means on said vehicle for generating hydrodynamic forces and means for selectively controlling the attitude of said vehicle. The "whereby" clause is merely a functional statement that recites no structure or means and is of no assistance in patentably defining over a reference. A submarine, as well as being submersible is a ship that proceeds on the surface (answer, page 2).

Rather than reiterate the examiner's full discussion of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 9, mailed December 10, 1965) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 8, filed October 22, 1965) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination which follows.

Having reviewed and evaluated the applied Anderson reference, we are of the opinion that the examiner's position in 1965 regarding the purported anticipation or obviousness of claim 11 on appeal improperly disregarded the details of the "means for selectively controlling" set forth in clause (c) of appellants' claim. In that regard, we do not share the examiner's view that the "whereby" clause associated with the "means for selectively controlling" of claim 11 can be disregarded, because, contrary to the examiner's position, we find that the "whereby" clause imposes certain structural limitations on the "means for selectively controlling" that are not found in Anderson.

More particularly, we consider that the examiner has failed to properly interpret the "means for selectively controlling" of appellants' claim 11 in accordance with 35 U.S.C. § 112, sixth paragraph. As was made clear in In re Donaldson Co. Inc., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994), the sixth paragraph of 35 U.S.C. § 112 permits an applicant to express an element in a claim for a combination as a means or step for performing a specified function without the recital of structure, materials or acts in support thereof, and mandates that such a claim limitation "shall be construed to cover the corresponding structure, materials, or acts described in the specification or equivalents thereof."

In this case, it is clear to us, as has been urged by appellants in their brief (pages 3-4), that the "means for selectively controlling the attitude of said vehicle" (answer, page 2) pointed to by the examiner in Anderson are not the same (structurally or functionally) as those described in appellants' specification, and it is also clear that the examiner has not attempted to articulate any reasoning as to why the structure of the applied Anderson patent should be considered to be an

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equivalent of that which is set forth in appellants' specification and claims.

The azimuth control system of the towed vehicle (10) of Anderson is used to position the towed vehicle beneath and behind a self-propelled towing vehicle by means of a tow line in such a manner that variations in the azimuth heading of the towing vehicle will cause the towed vehicle (10) to follow substantially directly astern of the towing vehicle. The control system of Anderson is not capable of positioning a hydrophone array substantially parallel to the axis of a submarine "at any radial position of the vehicle [towed vehicle] about the submarine," as required in claim 11 on appeal.

Since we have determined that the teachings and suggestions which would have been fairly derived from Anderson would not have anticipated the subject matter of claim 11, or have made the subject matter of claim 11 obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of that claim.

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In light of the foregoing, the decision of the examiner to
reject claim 11 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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